

### REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-24 and 42-48 are currently pending. Claims 70-75 have been cancelled without prejudice or disclaimer; and Claims 1, 3-5, 11, 14, 15, 17-19, 22-24, 42, 43, and 46-48 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.<sup>1</sup>

In the outstanding Office Action, Claims 1 and 72 were objected to as containing informalities; Claims 1-24, 42-48, and 70-75 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1-24, 42-48, 70-75 were rejected under 35 U.S.C. § 112, second paragraph, regarding questions of definiteness; Claims 1-11, 18-21, 42-45, 70, 72, and 74 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claims 1-14, 17-24, 42-48, and 70-75 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,317,786 to Yamane et al. (hereinafter “the ‘786 patent”); and Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘786 patent in view of U.S. Patent Application Publication No. 2004/0133656 to Butterworth et al. (hereinafter “the ‘656 application”).

### CLAIM OBJECTION

Regarding the objections to Claims 1 and 72, Claim 1 has been amended to remove the comma, as required by the Office Action. Accordingly, the objection to Claim 1 is believed to have been overcome. Further, it is respectfully submitted that the objection to Claim 72 is rendered moot by the present cancellation of that claim.

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<sup>1</sup> See, e.g., Figs. 7-9, and the discussion related thereto in the originally filed specification.

REJECTION UNDER 35 U.S.C. § 112

Regarding the rejections of Claims 1-24, 42-48, and 70-75 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the Office Action asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Office Action asserts that

[t]hese claims are repeated in the Summary of the Invention section of the specification, without further providing more detailed description. The drawings and the Detailed Description of the Preferred Embodiments section of the specification do not mention or describe claimed invention, Web service providing apparatus, at all. As a result, the specification does not support claimed invention.<sup>2</sup>

That is, the Office Action appears to simply assert that the claims are not supported because the Detailed Description of the Preferred Embodiments section of the specification does not explicitly recite the term “Web service providing apparatus.”

However, as noted in the previously filed Amendment, MPEP § 2163.02 provides that

[w]henver the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.

For a non-limiting example, it is noted that the originally filed specification, at least at page 64, lines 5-8 clearly discloses that **“the image forming apparatus 1200 according to the first embodiment provides a Web service to other apparatuses connected via a network.”** Accordingly, it is respectfully submitted that one of ordinary skill would

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<sup>2</sup> See Office Action dated April 15, 2009, page 6.

recognize the image forming apparatus 1200 as a non-limiting example of the claimed Web service providing apparatus. Thus, at least the disclosed image forming apparatus 1200 conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, that Applicant was in possession of the Web service providing apparatus as now claimed.

Further, it is respectfully submitted that the rejections of Claims 70-75 under 35 U.S.C. § 112, first paragraph, are rendered moot by the present cancellation of those claims. However, since independent Claims 1, 17, 18, 22-24, 42, and 46-48 have been amended to recite features analogous to the previously recited target information type, target information type determination part, and/or target information type determination step, Applicant will address the rejections of Claims 70-75 with in view of the amendments to the independent claims.

The Office Action rejects Claims 70-75 under 35 U.S.C. § 112, first paragraph, by simply asserting that “there is no support in the original specification for claimed subject matters ‘target information type’, ‘target information type determination part’, and ‘target information type determination step’.”<sup>3</sup> However, as noted above, MPEP § 2163.02 provides that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.”

For a non-limiting example, it is noted that the originally filed specification, at least at page 78, line 23 to page 79, line 15, discloses

the sequence control 310 of the image forming apparatus 1200 uses the document type determination part 320 to **determine whether or not there is a document type acquirable from the image forming apparatus 1000 and writable in the image forming apparatus 1200 based on the transmitter document type list 302 and the receiver document type list 304**, and then determines the best document type. Based on the determination, if there are a plurality of such document types, the document type determination part 320 determines one of the document types as the best document type. If there is no

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<sup>3</sup> See Office Action dated April 15, 2009, page 7.

such a document type, the document type determination part 320 determines a predetermined document type as the best document type. Then, the sequence control part 310 instructs the SOAP command creation part 210 to send to the image forming apparatus 1200 a ticket request command as a SOAP command.

Accordingly, it is respectfully submitted that one of ordinary skill would recognize the document type acquirable from the image forming apparatus 1000 and writable in the image forming apparatus 1200 as a non-limiting example of the claimed target information type. Thus, the disclosed document type conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, that Applicant was in possession of the target information type, target information type determination part, and determination step as now claimed.

Further, Applicant respectfully traverses the rejections of Claims 1-24, 42-48, and 70-75 under 35 U.S.C. § 112, second paragraph, as being replete with intended use recitations. With respect to Claims 1-16, 18-21, 23, 42-45, and 47, the Office Action apparently takes the position that the phrase “configured to” has no patentable weight because it “merely represents what the Web service providing apparatus and/or terminal intends to do or is capable of doing by way of its configuration.”<sup>4</sup> Therefore, the Office Action appears to be taking the position that a claimed Web service providing apparatus and terminal are only patentable when it defines a Web service providing apparatus or terminal that is in the act of performing a process. However, Applicant respectfully submit that a claim directed to a system or structure may define the configuration of its elements rather than a present action that the system or structure is performing. For example, the decision by the court in *In re Venezia*, 189 USPQ 149, 151-52 (CCPA 1976) held that the use of the words “adapted to” indicate a structural element. The court stated:

The claimed invention does include present structural limitations on each part \* \* \*. For example, paragraph two of claim 31 calls for "a pair of sleeves \* \* \*

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<sup>4</sup> See Office Action dated April 15, 2009, pages 7 and 8.

each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, *this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. \* \* \* .* (Emphasis added, citation omitted.)

Thus, Applicant submits that the use of “configured to” (like adapted to) in Claims 1-16, 18-21, 23, 42-45, and 47 impart a structural limitation because it describes the Web service providing apparatus’s or terminal’s present structural configuration rather than a mere direction of activities to take place in the future.

Further, it is noted that the Office Action does not provide any explanation as to the basis for the rejections of Claims 17, 22, 24, 46, and 48, which clearly recite steps of a method. Accordingly, should the Examiner wish to maintain the rejections of those claims, it is respectfully requested that the next Office Action specifically point out language in those claims “that suggests or makes optional but does not require steps to be performed,” as noted in MPEP § 2106(C).

Also, it is well established that each word of every claim must be given weight. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, it would be without merit to suggest that “configured to” language and the recited steps are of questionable limiting effect no matter how it is used in a claim.

Therefore, Applicant respectfully requests that the rejections of Claims 1-24, 42-48, and 70-75 under 35 U.S.C. § 112, second paragraph, as being replete with intended use recitations, be withdrawn.

Regarding the rejections of Claims 1, 3, 11, 14, 15, 19, and 22 under 35 U.S.C. § 112, second paragraph, Claims 1, 3, 11, 14, 15, 19, and 22 have been amended to address the informalities noted in the Office Action.

Further, Applicant respectfully traverses the rejection of Claim 1 under 35 U.S.C. § 112, second paragraph. Applicant notes that the Office Action asserts that it is unclear what is processable and by what in the limitation, it is unclear what the target information has to do with the performing in the limitation, and it is unclear what a result of the process really means.<sup>5</sup> However, Applicant respectfully submits that Claim 1 is merely broad in this regard and are not unclear. For example, with regard to Claim 1, one of ordinary skill in the art would clearly understand that a non-limiting example of the a processable condition may include a processable document type (e.g., target information type) corresponding to a document type that is acquirable by the image forming apparatus 1000 and writable by the image forming apparatus 1200;<sup>6</sup> that a non-limiting example of performing a requested process on target information may include an image forming apparatus 1200 that is requested to receive a document (e.g., target information) to be processed from an image forming apparatus 1000 and perform a predetermined process;<sup>7</sup> and a non-limiting example of sending a result of the process may include a page image request completion message.<sup>8</sup>

#### REJECTION UNDER 35 U.S.C. § 101

The Office Action rejects Claims 1-11, 18-21, 42-45, 70, 72, and 74 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As a preliminary matter, it is respectfully submitted that the rejections of Claims 70, 72, and 74 are rendered moot by the present cancellation of those claims. Further, with respect to Claims 1-11, 18-21, and 42-45, the Office Action appears to acknowledge that the controller recited in each of independent Claims 1, 18, and 42 corresponds to hardware, and thus corresponds to statutory subject matter, but simply asserts that the controller 1300 illustrated in Fig. 2 of the present

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<sup>5</sup> See Office Action dated April 15, 2009, page 8.

<sup>6</sup> See, e.g., page 70, line 17 to page 71, line 3 of the originally filed specification.

<sup>7</sup> See, e.g., page 67, line 19 to page 68, line 5 of the originally filed specification.

<sup>8</sup> See, e.g., Figure 8 and the discussion related thereto in the originally filed specification.

application “is for the image forming apparatus 1200, not for the Web service providing apparatus as claimed in claims 1, 18, and 42.”<sup>9</sup>

However, it is noted that the originally filed specification, at least at page 64, lines 5-8 clearly discloses that **“the image forming apparatus 1200 according to the first embodiment provides a Web service to other apparatuses connected via a network.”** Thus, as noted above, one of ordinary skill in the art would recognize the image forming apparatus that provides a Web service as a non-limiting example of the claimed Web service providing apparatus. Accordingly, Applicants respectfully traverse the rejections of Claims 1-11, 18-21, and 42-45 as being directed to non-statutory subject matter.

REJECTION UNDER 35 U.S.C. § 102

Amended Claim 1 is directed to A Web service providing apparatus, comprising:

a controller including

a server processing part configured to control receipt of a process request for a process from a requesting apparatus connected to the Web service providing apparatus via a communication network, and to control transmission of a process response corresponding to the process request to the requesting apparatus in accordance with a predetermined protocol, the process request including a command to retrieve target information from an image forming apparatus connected to the Web service providing apparatus via the communication network;

*a target information type determination part configured to determine a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type determination part being configured to determine the target information type based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus;*

a condition acquisition control part configured to control, in response to an instruction from the server processing

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<sup>9</sup> See Office Action dated April 15, 2009, page 10.

part, acquisition of the target information designated by the process request from the image forming apparatus that manages the target information based on the determined target information type; and

a service providing part configured to perform the requested process on the target information and to send a result of the process to the server processing part.

Regarding the rejection of Claim 1 under 35 U.S.C. § 102(e), the '786 patent is directed to a web service system that allows a system operator to manage multiple web servers. In particular, the '786 patent discusses a web service system 90 including various components 100-122 that can communicate over one or more computer networks. The '786 web service system 90 manages one or more hosts 100, that can be a computer system commercially available and capable of using a multi-threaded operating system such as UNIX or Windows NT, each including at least one web server 102.<sup>10</sup> The '786 patent discusses that a user interacts with the web server by making an initial request to the web server 102, which results in the web server 102 sending a web page in response, an aggregation of related web pages presented to the user being referred to as an application.<sup>11</sup> Further, the '786 patent discusses that the web service system 90 includes an interceptor 120 and manager 110 that perform load balancing,<sup>12</sup> and that the manager 110 monitors the hosts 100 based on information received from agents 106 included in the hosts 100.<sup>13</sup>

However, it is respectfully submitted that the '786 patent fails to disclose a target information type determination part configured to determine a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type determination part being configured to determine the target information type based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second

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<sup>10</sup> See '786 patent, column 4, lines 15-37.

<sup>11</sup> Id. at column 4, line 38 to column 5, line 28.

<sup>12</sup> Id. at column 7, lines 6-28.

<sup>13</sup> Id. at column 6, lines 46-65.



processable target information type list of the Web service providing apparatus. Rather, as noted above, the '786 patent simply discusses that web pages are provided in response to a user request. The '786 patent does not disclose a determination of a processable web page type between the user device requesting the web page and the web server 102. Thus, the '786 patent does not disclose determining ***a target information type that is processable by both the image forming apparatus and the Web service providing apparatus based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus***, as defined in Claim 1.

Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent claims) patentably defines over the '786 patent.

Amended Claim 17 recites, in part,

a determination step of determining a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type being determined based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Regarding the rejection of Claim 17 under 35 U.S.C. § 103(a), as noted above, the '786 patent fails to disclose the "target information type determination part" of Claim 1.

Thus, the '786 patent fails to disclose the determination step recited in Claim 17.

Accordingly, it is respectfully submitted that Claim 17 patentably defines over the '786 patent.

Amended Claim 18 recites, in part,

a service providing part configured to manage target information and to provide the target information to an image forming apparatus, which requests the target information based on a process request including a command to retrieve the target information from the Web service providing apparatus and

performs a process on the target information, in accordance with a target information type received from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 22 recites, in part,

a service providing step of managing, by the Web service providing apparatus, target information and providing the target information to an image forming apparatus, which requests the target information based on a process request including a command to retrieve the target information from the Web service providing apparatus and performs a process on the target information, based on a target information type received from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Regarding the rejection of Claims 18 and 22 under 35 U.S.C. § 102(e), as noted above, the '786 patent fails to disclose the determination of a target information type, as defined in Claim 1. Thus, the '786 patent fails to disclose the service providing part and the service providing step recited in Claims 18 and 22, respectively. Accordingly, it is respectfully submitted that Claims 18 and 22 patentably define over the '786 patent.

Amended Claim 23 recites, in part,

a process request creation part configured to create a process request to cause a first image forming apparatus to acquire target information managed by a second image forming apparatus from the second image forming apparatus in accordance with a target information type and perform a process on the target information in accordance with a predetermined protocol, wherein

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target

information type is shared between a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Amended Claim 24 recites, in part,

a process request creation step of creating a process request to request a first image forming apparatus to acquire target information managed by a second image forming apparatus from the image forming second apparatus in accordance with a target information type and perform a process on the target information in accordance with a predetermined protocol, wherein

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is shared between a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Regarding the rejections of Claims 23 and 24 under 35 U.S.C. § 103(a), as noted above, the '786 patent fails to disclose the determination of a target information type, as defined in Claim 1. Thus, the '786 patent fails to disclose the process request creation part and the process request creation step recited in Claims 23 and 24, respectively. Accordingly, it is respectfully submitted that Claims 23 and 24 patentably define over the '786 patent.

Amended Claim 42 recites, in part,

a service providing part configured to perform, in response to a process request, a process on target information received from an image forming apparatus that manages the target information in accordance with a target information type and to provide a result of the process to the image forming apparatus, the process request including a command to retrieve the target information from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 46 recites, in part,

a service providing step of performing, by the Web service providing apparatus, in response to a process request, a process on target information received from an image forming apparatus managing the target information in accordance with a target information type and providing a result of the process to the image forming apparatus, the process request including a command to retrieve the target information from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is shared between a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Regarding the rejections of Claims 42 and 46 under 35 U.S.C. § 103(a), as noted above, the '786 patent fails to disclose the determination of a target information type, as defined in Claim 1. Thus, the '786 patent fails to disclose the service providing part and the service providing step recited in Claims 42 and 46, respectively. Accordingly, it is respectfully submitted that Claims 42 and 46 (and all associated dependent claims) patentably define over the '786 patent.

Amended Claim 47 recites, in part,

a process request creation part configured to create a process request to cause a first image forming apparatus to perform a process on target information managed by a second image forming apparatus by sending the target information to the first image forming apparatus in accordance with a target information type, wherein

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is shared between a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Amended Claim 48 recites, in part,

a process request creating step of creating a process request to cause a first image forming apparatus to perform a process on target information managed by a second image forming apparatus by sending the target information to the first

image forming apparatus in accordance with a target information type, wherein

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is shared between a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Regarding the rejections of Claims 47 and 48 under 35 U.S.C. § 103(a), as noted above, the '786 patent fails to disclose the determination of a target information type, as defined in Claim 1. Thus, the '786 patent fails to disclose the process request creation part and the process request creating step recited in Claims 47 and 48, respectively. Accordingly, it is respectfully submitted that Claims 47 and 48 patentably define over the '786 patent.

#### REJECTION UNDER 35 U.S.C. § 103

Regarding the rejections of dependent Claims 15 and 16 under 35 U.S.C. § 103(a), it is respectfully submitted that the '656 application fails to remedy the deficiencies of the '786 patent, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 15 and 16 patentably define over any proper combination of the '786 patent and the '656 application.

#### CONCLUSION

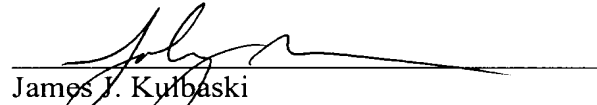
Thus, it is respectfully submitted that independent Claims 1, 17, 18, 22-24, 42, and 46-48 (and all associated dependent claims) patentably define over any proper combination of the '786 patent and the '656 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as

amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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